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09/123,109	07/27/1998	JAMES DUKE BOND	RIC-97-120	5163

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WORLDCOM, INC.
TECHNOLOGY LAW DEPARTMENT
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WASHINGTON, DC 20036

EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/123,109

Applicant(s)

BOND ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1, 10, 16, 19, 27 and 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett (US 5,923,734) in view of Cho (US 5,978,452).

Regarding **claim 1**, Taskett discloses an apparatus for providing a prepaid, remote memory transaction account with voice indicia (column 1, lines 11-17), (which reads on claimed "a system associated with a prepaid telephone calling card") (column 3, line 55 "prepaid calling cards"), comprising:

a data storage system (column 5, line 36 "voice storage facility") for storing data (column 5, line 42 "snippets") corresponding to a pre-paid telephone calling card (column 5, lines 30-45) [The voice snippets of celebrities are stored in the voice library]; and

a pre-paid telephone calling card processing system (column 5, line 59 "a distributed transaction system") coupled to the data storage system (column 5, lines 59-64) [A distributed transaction system is configured to communicate with the host computer network].

Taskett fails to disclose receive a request to record a personal greeting during a setup call.

However, Cho teaches receive a request (column 5, line 8 "recording mode") to record the personal greeting (column 5, line 9 "a personal voice message greeting") during a setup call (column 5, lines 12-13 "an off-hook condition") over a telephone network (column 3, line 50 "PSTN") and to cause the personal greeting to be recorded during the setup call (column 5, lines 8-18) [The user picks up the telephone and initiates a voice recording mode to record a personal greeting and the voice message is recorded by the system].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a request to record a personal greeting during a setup call of Cho in the invention of Taskett.

The modification of the invention would offer the capability of a request to record a personal greeting during a setup call such as the recipient of this card would be able to listen to the personal greeting.

Regarding **claim 10**, Taskett discloses a method for providing a prepaid, remote memory transaction account with voice indicia (column 1, lines 11-17), (which reads on claimed "a method associated with a prepaid telephone calling card") (column 3, line 55 "prepaid calling cards"), comprising the steps of:

storing data (column 5, line 42 "snippets") corresponding to a pre-paid telephone calling card (100 on FIG. 2) and a greeting (column 5, line 35 "voice of the celebrity") to be associated with a prepaid telephone calling card (column 5, lines 30-45) [The voice snippets of celebrities are stored in the voice library];

causing the greeting to be played back during an access call related to the use of the pre-paid telephone calling card (column 8, lines 20-29) [The Elvis record is played back to instruct the caller of time remaining on the prepaid card].

Taskett fails to disclose receiving a request to record a personal greeting during a setup call and causing the personal greeting to be recorded.

However, Cho teaches receiving a request (column 5, line 8 "recording mode") to record a personal greeting (column 5, line 9 "a personal voice message greeting")

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during a setup call (column 5, lines 12-13 "an off-hook condition") over a telephone network (column 3, line 50 "PSTN") and causing the personal greeting to be recorded during the setup call (column 5, lines 8-18) [The user picks up the telephone and initiates a voice recording mode to record a personal greeting and the voice message is recorded by the system].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use receiving a request to record a personal greeting during a setup call and causing the personal greeting to be recorded of Cho in the invention of Taskett.

The modification of the invention would offer the capability of receiving a request to record a personal greeting during a setup call and causing the personal greeting to be recorded such as the recipient of this card would be able to listen to the personal greeting.

Regarding **claim 16**, Taskett discloses a method for providing a prepaid, remote memory transaction account with voice indicia (column 1, lines 11-17 and column 3, line 55 "prepaid calling cards"), (which reads on claimed "a method of using a prepaid telephone calling card") comprising the steps of:

accessing a prepaid telephone calling card processing system (column 7, line 15 "service provider") during a pre-paid telephone calling card setup call (column 7, lines 13-14 "dialing access number") via a telephone network (column 7, lines 13-32)

[Depending of the image on the phone the user will dial an access number then the system will present the user a menu];

entering a card identifier (column 7, lines 38-39 "access code") corresponding to data addressable by the pre-paid telephone calling card system (column 7, lines 33-39)

[Additional information is requested from the user to access the system];

Taskett fails to disclose recording a personal greeting during a subsequent telephone service access call.

However, Cho teaches recording a personal greeting (column 5, line 9 "a personal voice message greeting") being addressable by the telephone processing system (column 3, line 50 "PSTN") during a subsequent telephone service access call (column 5, lines 8-18) [The user picks up the telephone and initiates a voice recording mode to record a personal greeting and the voice message is recorded by the system].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use recording a personal greeting during a subsequent telephone service access call of Cho in the invention of Taskett.

The modification of the invention would offer the capability of recording a personal greeting during a subsequent telephone service access call such as the recipient of this card would be able to listen to the personal greeting.

Regarding **claim 19**, Taskett discloses an apparatus for providing a prepaid, remote memory transaction account with voice indicia (column 1, lines 11-17), (which reads on claimed "a system for facilitating the use of a pre-paid telephone calling having an associated greeting"), comprising:

a data storage system (column 5, line 36 "voice storage facility") for storing data (column 5, line 42 "snippets") corresponding to a pre-paid telephone calling card (column 5, line 38 "telephone card") and to a greeting (column 5, line 37 "voice of celebrity") related to the pre-paid telephone calling card (column 5, lines 30-45) [The voice snippets of celebrities are stored in the voice library]; and

a pre-paid telephone calling card processing system (column 5, line 59 "a distributed transaction system") coupled to the data storage system and configured to receive a request to make an outbound telephone call (column 6, line 3 "long distance telephone calls") in relation to the pre-paid telephone calling card during an access call over a telephone network (column 5, lines 66-67 "Local Exchange Carrier") and to cause the greeting to be played during the access call (column 6, lines 59-65) [The user dials a particular telephone number to retrieve appropriate audio indicia].

Taskett fails to disclose recording a personal greeting.

However, Cho teaches recording a personal greeting (column 5, line 9 "a personal voice message greeting") (column 5, lines 8-18) [The user picks up the telephone and initiates a voice recording mode to record a personal greeting and the voice message is recorded by the system].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use recording a personal greeting of Cho in the invention of Taskett.

The modification of the invention would offer the capability of recording a personal greeting such as the recipient of this card would be able to listen to the personal greeting.

Regarding **claim 27**, Taskett discloses a method for providing a prepaid, remote memory transaction account with voice indicia (column 1, lines 11-17), (which reads on claimed "a method for facilitating the use of a pre-paid telephone calling card having an associated pre-recorded greeting"), comprising:

storing data (column 5, line 42 "snippets") corresponding to a pre-paid telephone calling card (column 5, line 38 "telephone card") and a greeting (column 5, line 35 "voice of the celebrity") to the prepaid telephone calling card (column 5, lines 30-45) [The voice snippets of celebrities are stored in the voice library];

receiving a request (column 6, line 6 "the completion") to make an outbound telephone call (column 6, line 3 "long distance telephone calls") in relation to the pre-paid telephone calling card during an access call over a telephone network (column 5, lines 66-67 "Local Exchange Carrier") (column 5, line 59 to column 6, line 7) [The user dials a particular telephone number to request an outbound call such as a long distance call]; and

causing the greeting to be played during the access call (column 6, lines 59-65)

[The user dials a particular telephone number to retrieve appropriate audio indicia].

Taskett fails to disclose recording a personal greeting.

However, Cho teaches recording a personal greeting (column 5, line 9 “a personal voice message greeting”) (column 5, lines 8-18) [The user picks up the telephone and initiates a voice recording mode to record a personal greeting and the voice message is recorded by the system].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use recording a personal greeting of Cho in the invention of Taskett.

The modification of the invention would offer the capability of recording a personal greeting such as the recipient of this card would be able to listen to the personal greeting.

Regarding **claim 31**, Taskett discloses a method for providing a prepaid, remote memory transaction account with voice indicia (column 1, lines 11-17 and column 3, line 55 “prepaid calling cards”), (which reads on claimed “a method of using a pre-paid telephone calling card”) comprising the steps of:

accessing a prepaid telephone calling card processing system (column 7, line 15 “service provider”) during a pre-paid telephone calling card setup call (column 7, lines 13-14 “dialing access number”) via a telephone network (column 7, lines 13-32)

[Depending of the image on the phone the user will dial an access number then the system will present the user a menu];

entering a card identifier (column 7, lines 38-39 "access code") corresponding to data addressable by the pre-paid telephone calling card system (column 7, lines 33-39)

[The system prompts the user to enter an access code over the telephone line];

retrieving a pre-recorded greeting (column 7, line 50 "inform the consumer") associated with the pre-paid telephone calling card based on the card identifier entered during the entering step (column 7, lines 40-52) [the system informs the costumer of the long distance time using the Elvis voice]; and

playing the pre-recording greeting associated with the pre-paid telephone calling card during the telephone access service access call (column 8, lines 1-9) [The system will play the Elvis snippets when the user have Elvis image on the transaction card].

Taskett fails to disclose recording a personal greeting.

However, Cho teaches recording a personal greeting (column 5, line 9 "a personal voice message greeting") (column 5, lines 8-18) [The user picks up the telephone and initiates a voice recording mode to record a personal greeting and the voice message is recorded by the system].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use recording a personal greeting of Cho in the invention of Taskett.

The modification of the invention would offer the capability of recording a personal greeting such as the recipient of this card would be able to listen to the personal greeting.

4. **Claims 2, 18 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett in view of Cho and in further view of Khuc et al (US 5,828,740).

Regarding **claims 2 and 20**, Taskett and Cho as applied to **claims 1 and 19** above differ from **claims 2 and 20** in that it fails to disclose the data storage system and the pre-paid calling card processing system are remotely located.

However, Khuc discloses the data storage system and the pre-paid calling card processing system are remotely located (column 3, lines 44-54).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the data storage system and the pre-paid calling card processing system are remotely located of Khuc in the invention of Taskett and Cho.

The modification of the invention would offer the capability of a request to record the greeting during a setup call such as the recipient of this card would be able to listen to the message on the greeting card.

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Regarding **claim 18**, Taskett and Cho as applied to **claim 16** above differ from **claim 18** in that it fails to disclose the telephone network is the publicly switched telephone network.

However, Khuc teaches the telephone network is the publicly switched telephone network (column 2, lines 27-32).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the telephone network is the publicly switched telephone network of Khuc in the invention of Taskett and Cho.

Doing so the system would play back the greeting message.

5. **Claims 3-4, 11-12, 21-22, 28 and 32-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett in view of Cho and in further view of Bruno et al. (US 5,991,380).

Regarding **claims 3, 11, 21 and 28**, Taskett and Cho as applied to **claims 1, 10, 19 and 27** above differ from **claims 3, 11, 21 and 28** in that it fails to disclose a quantity corresponding to a number of service units.

However, Bruno teaches the data corresponding to the pre-paid telephone calling card includes a quantity corresponding to a number of service units available to be used to make at least one call in relation to the pre-paid telephone calling card (column 2, lines 22-27).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a quantity corresponding to a number of service units of Bruno in the invention of Taskett and Cho.

Doing so the system would provide access to telecommunications services.

Regarding **claims 4, 12 and 22**, Taskett discloses the call is a long distance telephone call (column 6, lines 1-3).

Regarding **claim 32**, Taskett and Cho as applied to **claim 31** above differs from **claim 30** in that it fails to disclose an outbound call will be placed automatically.

However, Bruno teaches the step of entering a terminating telephone number to which an outbound call will be placed automatically after the pre-recorded personal greeting has been played (column 3, lines 51-54).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use an outbound call will be placed automatically of Bruno in the invention Taskett and Cho.

Doing so the system would provide access to telecommunications services.

Regarding **claim 33**, Taskett and Cho as applied to **claim 31** above differs from **claim 33** in that it fails to disclose the accessing and entering steps are carried out remotely.

However, Bruno discloses the accessing and entering steps are carried out remotely from the retrieving and playing steps (column 2, lines 22-27).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the accessing and entering steps are carried out remotely of Bruno in the invention Taskett and Cho.

Doing so the system would provide access to telecommunications services.

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6. **Claims 5, 13, 23 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett in view of Cho in view of Bruno and in further view of Nguyen et al. (US 5,815,561).

Regarding **claims 5, 13, 23 and 29**, Taskett, Cho and Bruno as applied to **claims 3, 12, 21 and 28** above differ from **claims 5, 13, 23 and 29** in that it fails to disclose service units correspond to telephone call service minutes.

However, Nguyen teaches a system, wherein the service units correspond to telephone call service minutes (column 13, lines 30-36).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use service units correspond to telephone call service minutes of Nguyen in the invention of Taskett, Cho and Bruno.

Doing so the system would provide a cost call service minutes.

7. **Claims 6-9, 14-15, 17, 24-26 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett in view of Cho and in further view of Gow (US 5,828,732).

Regarding **claims 6, 14 and 24**, Taskett and Cho as applied to **claims 1, 10 and 19** above differ from **claims 6, 14 and 24** in that it fails to disclose the personal greeting to be recorded within the data storage system in accordance with a card identifier.

However, Gow teaches the pre-paid telephone calling card processing system causes the personal greeting to be recorded within the data storage system in accordance with a card identifier corresponding to the pre-paid telephone calling card (column 4, lines 56-60).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the personal greeting to be recorded within the data storage system in accordance with a card identifier of Gow in the invention Taskett and Cho.

Doing so the system would provide the personal greeting.

Regarding **claims 7 and 25**, Taskett and Cho as applied to **claims 1 and 19** above differ from **claims 7 and 25** in that it fails to disclose the data storage system, and operative to store the personal greeting based on a card identifier.

However, Gow teaches a voice data storage facility coupled to the pre-paid telephone calling card processing system (1 and 4 on FIG. 1) and to the data storage

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system, and operative to store the personal greeting based on a card identifier corresponding to the pre-paid telephone calling card (column 4, lines 11-15).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the data storage system, and operative to store the personal greeting based on a card identifier of Gow in the invention of Taskett and Cho.

Doing so the system would provide the greeting message.

Regarding **claims 8 and 26**, Taskett and Cho as applied to **claims 1 and 19** above differ from **claims 8 and 26** in that it fails to disclose to prompt a caller to record the personal greeting.

However, Gow teaches a voice response system coupled to the pre-paid calling card processing system and configured to prompt a caller to record the personal greeting via at least one voice prompt during the setup call over the telephone network (column 43, lines 40-55).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use prompting a caller to record the personal greeting of Gow in the invention of Taskett and Cho.

Doing so the system would record the greeting message.

Regarding **claim 9**, Taskett and Cho as applied to **claim 1** above differ from **claim 9** in that it fails to disclose the personal greeting is to be played back.

However, Gow teaches the personal greeting is to be played back via the pre-paid telephone calling processing system during an access call related to the pre-paid telephone calling card, the access call made in accordance with the use of the pre-paid telephone calling card (column 4, lines 60-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the personal greeting is to be played back of Gow in the invention of Taskett and Cho.

Doing so the system would play back the greeting message.

Regarding **claims 15 and 30**, Taskett and Cho as applied to **claims 10 and 27** above differ from **claims 15 and 30** in that it fails to disclose to be played back automatically during an access call.

However, Gow teaches the personal greeting stored during the causing step is to be played back automatically during an access call related to the pre-paid telephone calling card (column 4, lines 56-60).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use to be played back automatically during an access call of Gow in the invention of Taskett and Cho.

Doing so the system would play back the greeting message.

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Regarding **claim 17**, Taskett and Cho as applied to **claim 16** above differ from **claim 17** in that it fails to disclose the personal greeting is stored in a data storage system in accordance with the card identifier.

However, Gow teaches the personal greeting is stored in a data storage system in accordance with the card identifier (column 4, lines 56-60).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the personal greeting is stored in a data storage system in accordance with the card identifier of Gow in the invention of Taskett and Cho.

Doing so the system would play back the greeting message.

Response to Arguments

8. Applicant's arguments with respect to **claims 1-33** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



g.g.
February 20, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

